

REMARKS

In the office action, the Examiner (1) rejected Claims 1-21 and 56-63 under 35 U.S.C. § 101 as being directed to non-statutory subject matter, (2) rejected Claims 1, 2, 7-9, 11-14, 20, 22-24, 26-57, 62 and 63 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,285,987 issued to Roth et al. ("Roth"), (3) rejected Claims 3-6 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Roth, (4) rejected Claims 15-18 under 35 U.S.C. § 103(a) as being unpatentable over Roth in view of U.S. Patent No. 6,049,777 issued to Sheena et al. ("Sheena"), (5) rejected Claim 19 under 35 U.S.C. § 103(a) as being unpatentable over Roth in view of U.S. Patent No. 6,298,348 issued to Eldering ("Eldering"), (6) rejected Claims 21 and 58-61 under 35 U.S.C. § 103(a) as being unpatentable over Roth in view of U.S. Patent No. 6,295,061 issued to Park et al. ("Park"), and (7) rejected Claim 25 under 35 U.S.C. § 103(a) as being unpatentable over Roth in view of U.S. Patent No. 6,366,298 issued to Haitsuka ("Haitsuka"). Reconsideration and allowance of the application, as amended, are requested.

I. § 101 Rejections

The Examiner initially rejected Claims 1-21 and 56-63 under 35 U.S.C. § 101, stating that the claims are directed to non-statutory subject matter. The Examiner's basis for this rejection is that the claims do not advance the technological arts since the recited steps could be performed using pencil and paper. In order to clarify that the steps are not performed using pencil and paper, the rejected claims have been amended to specify that steps are performed using a computer. It would be impractical and very difficult, if at all possible, to perform the steps in accordance with various embodiments of the invention using pencil and paper given that in a typical implementation, many Web users (perhaps thousands) can be profiled based on high volumes of Web traffic. The rejection of claims under § 101 should therefore be withdrawn.

II. Prior Art Rejections

The Examiner rejected Claims 1, 2 7-9, 11-14, 20, 22-24, 26-57, 62 and 63 under § 102(e) as being anticipated by Roth. Claim 1 of the present application is directed to a method of profiling a Web user. The method includes providing profiles on a plurality of Web sites, monitoring which of those Web sites the user accesses, and developing a profile of the user by inferring user demographics based on the profiles of the Web sites accessed by the user. Demographic data can include, without limitation, data on the user's age, gender, income, and highest attained education level, as indicated, e.g., in Claims 3-6, respectively. Demographics such as these are inferred for a user based on the profiles of the Web sites accessed by the user.

Roth is directed to a system for auctioning online advertising. It uses cookies to collect information on which sites the user visits, and provides this information to bidding agents of potential advertisers. Roth does not disclose or suggest the claimed method of profiling a Web user. In particular, Roth does not disclose or suggest developing a profile of the user by inferring demographics of the user based on the profiles of the Web sites accessed by the user. Roth simply compiles information on which sites a given user has accessed. Advertisers can submit proposed bids to their bidding agents specifying, e.g., that they are willing to pay five cents for displaying an ad to a viewer who has accessed at least three financially oriented data bases within the last week. (Col. 4, lines 65-67).

As will be discussed below, Roth also appears to stores some demographic data on the user. This data is, however, collected directly from the user through questionnaires at viewer registration time. Roth does not in any way disclose or suggest inferring user demographics based on the profiles of the Web sites they have accessed.

The Examiner contends that Roth develops user profiles through "updates information via view-op, see column 4, lines 26-31." However, Roth here only teaches

that when a viewer accesses a Web page, the advertising Web server updates information about which Web sites the user has accessed. The Web server never infers user demographics based on the profiles of the Web sites accessed. Rather Roth's Web server simply maintains a list of the Web sites accessed by the user. As noted above, Roth's Web server also apparently stores viewer demographic information. This information, however, is directly collected by a Web site at viewer registration time (col. 9, lines 1-5), and is in no way inferred from the profiles of the Web sites accessed by the user.

The Examiner states that Roth discloses viewer demographics as characteristics of the view-op based upon Web sites visited. As described in Column 2 of the reference, a view-op is what Roth refers to as a "view opportunity," which results from a viewer accessing a particular Web page. View ops have "characteristics" and are presented to advertisers (and their bidding agents) who evaluate the characteristics to determine their bids in the auction. "The characteristics of each view op include the characteristics of the particular Web site and Web page being accessed and the characteristics of the viewer including demographic information about the viewer and information as to what other sites this view has accessed in various periods of time." (col. 2, lines 14-19). As previously mentioned, this demographic information about the viewer is gathered at registration using questionnaires. (col. 9, lines 1-4). Roth does not teach inferring user demographics from Web site profiles. There is simply no discussion of this, much less of any methodology of how demographics could be inferred. By obtaining demographic information directly from the user at registration time, Roth obviates any need to infer this information.

Each of Claims 1-5, 7-9, 11-14, 20, 22-57, 62 and 63 rejected under § 102 is patentable over Roth.

Claim 11 specifies that monitoring which of said plurality of Web sites the user accesses comprises identifying URL requests made by the user while Web surfing. Claim 12, which depends on Claim 11, further specifies that the URL requests made by the user are identified at an ISP point of presence. This is not disclosed or suggested by Roth, which only discloses collecting information on Web sites viewed using cookies in a user's browser. The Examiner states that Roth discloses a client browser 711 that sends Web HTML references to an ISP (see column 19, lines 31-35). Roth here however only teaches that the client browser sends Web HTML references to an ISP, which in turn sends the references to Roth's remotely located advertising server system. There is no teaching that the ISP monitors the Web sites visited by the user, much less by identifying URL requests. The rejection of Claims 11 and 12 should be withdrawn.

Claim 23 is dependent on Claim 22 and specifies that the computer for profiling a Web user is an ISP point of presence server. The Examiner contends that this is disclosed by ISP 712 connected to servers 716 in FIGURE 7. While the server 716, which is Roth's advertising server, is connected to the ISP 712, the ISP merely sends certain data to the server 716. The ISP does not in any way profile Web users, and does not have the elements of the computer specified in Claims 22 and 23. These rejections should therefore be withdrawn.

Claim 25 specifies that the program includes a sniffer for identifying URL requests made by the user while Web surfing. Roth discloses use of cookies to collect data; it does not disclose or in any way suggest use of sniffers, which are substantially different from cookies. There is no suggestion or teaching whatsoever that one could (or would even want to) replace Roth's cookie system with a sniffer. This rejection should also be withdrawn.

Claim 19 was also rejected as being obvious over Roth in view of Eldering. Claim 19 specifies erasing records of which Web sites the user has visited after

developing the user's profile to protect user privacy. This is not disclosed or in any way suggested by Roth. Roth does not even recognize any need to protect user privacy. Roth deletes the oldest HUD record when the maximum record size is reached (see Col. 17, lines 30-31). The deletion is not performed to protect user privacy, and actually does not protect privacy since other user records remain. In fact, for the system of Roth to work, a list of Web sites visited by the user must always be stored because this information is provided to and needed by the bidding agents for evaluating whether and how much to bid for an ad placement. Accordingly, one skilled in the art would not consider combining Roth with a reference that teaches erasing the needed records of Web sites a user has visited. The combination of Roth with Eldering is thus improper. This rejection should also be withdrawn.

Claims 1-63 are pending in the present application. As each claim is allowable over the cited references, issuance of a Notice of Allowance is respectfully requested.

Respectfully submitted,



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